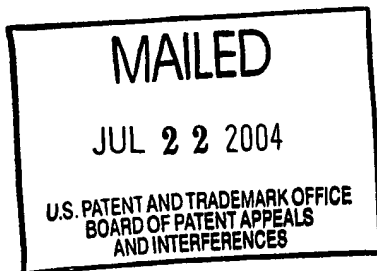


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte ANDREW D. BAROFSKY
and
KENTON W. GREGORY

Application No. 08/797,770

ORDER RETURNING UNDOCKETED APPEAL

This application was received at the Board of Patent Appeals and Interferences on July 13, 2004. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith returned to the examiner. The matters requiring attention prior to docketing are identified below.

A review of the application indicates that Terminal Disclaimers were filed December 3, 2001 (Paper Nos. 30 and 31) and March 24, 2003 (Paper No. 44). However, there is no indication in the record regarding whether these Terminal Disclaimers have been considered by the examiner.

In addition, on page 3 of the Examiner's Answer mailed October 21, 2003 (Paper No. 47), the examiner listed the following references under the heading "(9) Prior Art of Record";

| | | |
|--------------|---------------|---------|
| WO 96/14807 | Gregory et al | 05-1996 |
| US 5,428,014 | Labroo et al | 06-1995 |

It is noted that the Journal of Biological Chemistry reference cited on page 5 of the Examiner's Answer under the heading "Grounds of Rejection" is not included as "Prior Art of Record." In accordance with § 1211 of the Manual of Patent Examining Procedure (MPEP) (8th Ed., Rev. 1, Feb. 2003), clarification is required regarding the pertinence of the Journal of Biological Chemistry reference. In addition, MPEP § 1208(A)(9) states:

(A) REQUIREMENTS FOR EXAMINER'S ANSWER.
The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

. . . .

(9) References of Record. A listing of the references of record relied on, and, in the case of nonpatent references, the relevant page or pages.

If appropriate, compliance with MPEP § 1208(A)(9) is required in listing the Journal of Biological Chemistry reference under the heading "Prior Art of Record" appearing in the Examiner's Answer mailed October 21, 2003 (Paper No. 47).

Accordingly, it is

ORDERED that the application is returned to the Examiner:

1. for consideration of the Terminal Disclaimers filed December 3, 2001 (Paper Nos. 30 and 31) and March 24, 2003 (Paper No. 44);

2. for clarification under MPEP § 1211 regarding the pertinence of the Journal of Biological Chemistry reference listed on page 5 of the Examiner's Answer mailed October 21, 2003 (Paper No. 47);

3. if appropriate, for compliance with MPEP § 1208(A)(9) by listing the Journal of Biological Chemistry reference in a Supplemental Examiner's Answer under the heading "References of Record";

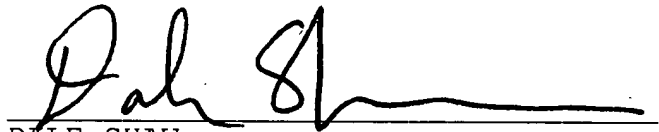
Application 08/797,770

4. for notification to appellants regarding the action
taken; and

5. for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By:



DALE SHAW

Program and Resource Administrator
(703) 308-9797

cc: Marger Johnson & McCollom PC
1030 SW Morrison Street
Portland, OR 97205

ds/psb/dm
RA040688